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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,337	01/14/2002	Wayne Ernest Conrad	5562-1047PCMDC	7423

1059 7590 10/28/2002

BERESKIN AND PARR
SCOTIA PLAZA
40 KING STREET WEST-SUITE 4000 BOX 401
TORONTO, ON M5H 3Y2
CANADA

EXAMINER
CHIESA, RICHARD L

ART UNIT	PAPER NUMBER
1724	6

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary	Application No.	Applicant(s)	
	10/043,337	CONRAD ET AL.	
	Examiner	Art Unit	
	Richard L. Chiesa	1724	

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *2-6,11-14 and 17-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-10,15 and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-22* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. The amendment filed September 16, 2002 has been entered.

Election/Restriction

2. Applicants' election without traverse of invention I and species C (Figures 4-9) in Paper No. 4, filed on September 16, 2002 is acknowledged.

3. Claims 2-6, 11-14, and 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species. Election was made **without** traverse in Paper No. 4, filed on September 16, 2002.

Specification

4. The disclosure is objected to because the specification fails to indicate that parent case Serial No. 09/478,891 is now U.S. Patent No. 6,383,266. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 1,7-9, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, the reasons for this rejection are: (A) Claim 1 is vague due to the presence of the ambiguous expression "for the dirty air inlet" in line

3. Perhaps, this phrase should be changed to -- from the dirty air inlet --. (B) Claim 16 is vague due to the presence of the ambiguous expression "in n" in the second line. Perhaps, this phrase should be changed to -- in --.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 7-10, 15, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7-10, and 15 of applicants' U.S. Patent No. 6,383,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims appear to be broader than the patented claims and therefore are completely encompassed by the patented claims. It is also noted that applicants have apparently elected the same invention and species in this application as elected in the patented case.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al in view of any one of Melito et al, Japanese Patent No. 1-209038, or German Patent No. 3143489. Frey et al (note Figures 1 and 9) show a vacuum cleaner with a dirty air inlet 22, clean air outlet 54, cyclone C, and a removable electrostatic precipitator filter 80 positioned downstream from the cyclone substantially as claimed. It would appear that Frey et al do not disclose the use of battery operation. However, each one of Melito et al (note col. 5, line 44 to col. 6, line 40), Japanese Patent No. 1-209038 (note ref. num. 6, 19, Figures 1-7, and first page of English translation), and German Patent No. 3143489 (note ref. num 14, Fig. 2, and pages 7 and

8 of the English translation) teaches the well-known use of battery operation in a vacuum cleaner for the purpose of maximizing convenience. Consequently, it would have been readily obvious to one having ordinary skill in the art to employ battery operation in the Frey et al vacuum cleaner in order to facilitate convenient usage as taught by any one of Melito et al, Japanese Patent No. 1-209038, or German Patent No. 3143489.

11. Claims 7-9, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 10 in paragraph 10 above, and further in view of any one of Dyson ('976), Finke, or Soler et al. The prior art as described above in paragraph 10 disclose a vacuum cleaner substantially as claimed with the apparent exception of a removable cyclone. In any case, each one of Dyson ('976) (note ref. num. 11-14, Figure 2, and col. 3, lines 1-66), Finke (note ref. num. 30, Fig. 1, and col. 3, lines 55-68), and Soler et al (note ref. num. 60, Figures 3-6, and col. 5, line 8 to col. 6, line 64) teaches the use of this well-known expedient in a vacuum cleaner for the purpose of providing further operating convenience and easier maintenance. Therefore, it would have been obvious to one having ordinary skill in the art to employ a removable cyclone in any one of the prior art vacuum cleaners in order to facilitate operating convenience and maintenance as taught by any one of Dyson ('976), Finke, or Soler et al.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references have been cited as art of interest to show other vacuum cleaners and/or electrostatic precipitators.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (703) 308-3791.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

Facsimile correspondence to Art Unit 1724 must be transmitted through (703) 305-7718. This number is for Art Unit 1724 correspondence only.

Richard L. Chiesa
10/25/2002

Richard L. Chiesa

RICHARD L. CHIESA
PRIMARY EXAMINER
ART UNIT 1724

Oct. 25, 2002